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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|--|
| Proceeding | 91205376 |
| Party | Defendant ProctorU, Inc. |
| Correspondence Address | HOWARD M GITTEN EDWARDS ANGELL PALMER & DODGE LLP PO BOX 130 NEW YORK, NY 10150-0130 UNITED STATES hgitten@edwardswildman.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Howard M. Gitten |
| Filer's e-mail | trademark@edwardswildman.com, clondon@edwardswildman.com |
| Signature | /howard m gitten/ |
| Date | 08/03/2012 |
| Attachments | PROCTORU TTAB Answer.pdf (12 pages)(834478 bytes) |

Registrations Subject to the filing

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| Registration No | 1768263 | Registration date | 04/27/1993 |
| Registrant | FINANCIAL INDUSTRY REGULATORY AUTHORITY, INC. 1735 K STREET, N.W. WASHINGTON, DC 20006 UNITED STATES | | |
| Grounds for filing | The registered mark has been abandoned. | | |

Goods/Services Subject to the filing

Class 042. First Use: 1992/10/00 First Use In Commerce: 1992/10/00
All goods and services in the class are requested, namely: training, educational testing and certification of professional and employment skills and abilities

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| Registration No | 1766565 | Registration date | 04/20/1993 |
| Registrant | FINANCIAL INDUSTRY REGULATORY AUTHORITY, INC. 1735 K STREET, N.W. WASHINGTON, DC 20006 UNITED STATES | | |
| Grounds for filing | The registered mark has been abandoned. | | |

Goods/Services Subject to the filing

Class 009. First Use: 1992/07/00 First Use In Commerce: 1992/07/00
All goods and services in the class are requested, namely: computer programs for training, testing, and certification of professional and employment skills and abilities

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|-----------------|--|-------------------|------------|
| Registration No | 1920891 | Registration date | 09/19/1995 |
| Registrant | FINANCIAL INDUSTRY REGULATORY AUTHORITY, INC. 1735 K STREET, N.W. WASHINGTON, DC 20006 | | |

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| | UNITED STATES |
| Grounds for filing | The registered mark has been abandoned. |

Goods/Services Subject to the filing

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| Class 016. First Use: 1992/07/01 First Use In Commerce: 1992/07/01 All goods and services in the class are requested, namely: booklets, pamphlets and brochures for training, testing and certification of professional and employment skills and abilities |
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| Registration No | 1797000 | Registration date | 10/05/1993 |
| Registrant | FINANCIAL INDUSTRY REGULATORY AUTHORITY, INC. 1735 K STREET, N.W. WASHINGTON, DC 20006 UNITED STATES | | |
| Grounds for filing | The registered mark has been abandoned. | | |

Goods/Services Subject to the filing

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| Class 016. First Use: 1992/07/00 First Use In Commerce: 1992/07/00 All goods and services in the class are requested, namely: computer and facilities manuals for training, testing and certification of professional and employment skills and abilities |
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skills and abilities; computer programs for training, testing and certification of professional and employment skills and abilities; booklets, pamphlets and brochures for training, testing and certification of professional employment skills and ability; and computer and facilities manuals for training, testing and certification of professional and employment skills and abilities. With respect to the grounds for opposition, ProctorU responds as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth that FINRA is a not for profit corporation; and that it is a self-regulatory organization registered with the Security Exchange Commission as a National Securities Association pursuant to Federal Law and therefore it is denied. Applicant is without knowledge or information sufficient to form a belief as to the truth that SRO, FINRA is involved in the registration of securities markets, brokerage firms and individual brokers and therefore it is denied. Applicant is without knowledge or information sufficient to form a believe as to the truth that there are about 4540 FINRA member firms and 631725 brokers and therefore it is denied. Applicant is without knowledge or information sufficient to form a belief that FINRA develops rules and regulations, and designs and operates marketplace services and facilities for use by investment brokerage firms and their employees, and also for use by investors, and therefore it is denied.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth that for two decades FINRA has used its PROCTOR mark in connection with computer programs, training, educational testing and certification services, and also booklets, pamphlets, brochures and manuals for training, testing and certification purposes, and

therefore it is denied. Applicant is without knowledge or information sufficient to form a belief as to the truth that FINRA owns several incontestable federal trademark registrations for its PROCTOR mark and therefore it is denied.

3. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA owns federal trademark registration Reg. No. 1768263 for the PROCTOR mark, covering "training, educational testing and certification of professional and employment skills and abilities" in Class 042. Applicant admits that according to the TARR database of the United States Patent and Trademark Office the registration issued April 27, 1993. Applicant is without knowledge or information sufficient to form a belief as to the truth that the mark has become incontestable and therefore it is denied. Applicant admits that according to the United States Patent and Trademark Office TARR database, that the registration was renewed on December 21, 2003. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA asserted that it has used its PROCTOR mark with the specified services since at least as early as October, 1992. Applicant admits that Exhibit A is a copy of the TARR print out page for this registration.

4. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA is the owner of Federal Trademark Registration No. 1766565 for the PROCTOR mark, covering "computer programs for training, testing, and certification of professional and employment skills and abilities" in Class 009. Applicant admits that according to the United States Patent and Trademark Office TARR database, the registration issued on April 20, 1993. Applicant is without knowledge or information sufficient to form a belief as to the truth that the mark has become incontestable and therefore it is denied.

Applicant admits that according to the United States Patent and Trademark Office TARR database, the registration was renewed on December 31, 2003. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA stated in its registration that it has used the PROCTOR mark in connection with computer programs since at least as early as July, 1992. Applicant admits that a copy of the TARR printout page for this registration from the United States Patent and Trademark Office website is attached as Exhibit B.

5. Applicant admits that according to the United States Patent and Trademark Office TARR database FINRA is the owner of Federal Trademark Registration No. 1,920,891 for the mark PROCTOR covering “booklets, pamphlets and brochures for training, testing and certification of professional and employment skills and abilities” in Class 016. Applicant admits that according to the United States Patent and Trademark Office TARR database, the PROCTOR mark has been registered since September 19, 1995. Applicant is without knowledge or information sufficient to form a belief as to the truth that the mark has become incontestable and therefore denies the same. Applicant admits that according to the United States Patent and Trademark Office TARR database, the registration was renewed on July 12, 2005. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA stated that it has used the PROCTOR mark in connection with these publications since at least as early as July 1, 1992. Applicant admits that Exhibit C is a copy of the TARR page for the registration.

6. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA is the owner of Federal Trademark Registration 1,797,000 for

the mark PROCTOR covering "computer facilities manuals for training, testing and certification of professionals and employment skills and abilities" in Class 016. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA's PROCTOR mark has been registered since October 5, 1993. Applicant is without knowledge or information sufficient to form a belief as to the truth that the mark has become incontestable and therefore denies the same. Applicant admits that according to the United States Patent and Trademark Office TARR database, the registration was renewed on December 13, 2003. Applicant admits that according to the United States Patent and Trademark Office TARR database, FINRA stated in its registration that it has used the PROCTOR mark in connection these publications since at least as early as July, 1992. Applicant admits that Exhibit D is a copy of the TARR printout page for this registration.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth that in addition to the products and services identified in the registrations, FINRA has used the PROCTOR mark for a variety of other related products and services, including providing administration and delivery of computer-based testing; and providing a variety of exams and training sessions related to areas including but not limited to skills, professional and vocational training; and for providing testing centers wherein the computer-based training sessions occur and therefore denies the same.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth that through continuous and extensive use, of the PROCTOR mark for two decades for the products and services identified above, FINRA's PROCTOR mark has become identified exclusively with FINRA and therefore it is denied. Applicant is without knowledge

or information sufficient to form a belief as to the truth that FINRA has developed substantial goodwill in its PROCTOR mark and the PROCTOR mark has become famous and well known and therefore it is denied.

9. Applicant admits that it seeks to register PROCTORU (Serial No. 85/345,247) for "online educational testing services in the field of distant learning, namely, administering standardized tests" in international Class 041. Applicant admits that the application was filed after FINRA's registrations for its PROCTOR mark. Applicant is without knowledge or information sufficient to form a belief as to when FINRA's registration for PROCTOR ever became incontestable, and therefore it is denied.

10. Applicant denies that the PROCTORU designation incorporates FINRA's PROCTOR mark entirely, and is nearly identical in sight, sound and meaning to FINRA's PROCTOR marks.

11. Applicant admits that FINRA has not authorized Applicant's use of Applicant's distinctive mark PROCTORU designation, nor the application therefore.

12. Applicant denies that the services identified in the application are or would be competitive, closely related to and/or complementary with the products and services that FINRA promotes and sells under its PROCTOR mark. Applicant denies that purchasers and prospective purchasers would believe that Applicant's PROCTORU services emanate from FINRA or are sponsored or endorsed by FINRA, even when they are not, or that there is an affiliation between FINRA and Applicant, when there is not.

13. Applicant denies that the applied for designation incorporates entirely FINRA's PROCTOR mark, and that Applicant purports to use PROCTORU for competitive, closely

related or complementary services. Applicant denies that its goods or services, are offered or are to be offered through overlapping channels to at least some of the same type of purchasers and consumers. Applicant denies that Applicant's proposed designation is likely to cause confusion, or to cause mistake, or to deceive or disparage by falsely suggesting in connection with or otherwise damaging FINRA. Applicant denies that its proposed designation is likely to cause confusion, or to cause mistake with FINRA marks. Applicant denies that the FINRA marks are famous, or that Applicant's marks will cause dilution.

AFFIRMATIVE DEFENSES

1. There is no likelihood of confusion, mistake or deception of the purchasing public between ProctorU's PROCTORU and Opposer's PROCTOR marks. When the marks are compared in their entirety, the marks are distinctly different in overall sound, appearance and commercial impression, such that there is no reasonable likelihood of confusion.

2. There is no likelihood of confusion, mistake or deception of the purchasing public between ProctorU's PROCTORU and Opposer's PROCTOR Mark. ProctorU provides different services to a different customer base so that there is no likelihood of confusion.

3. Opposer can not demonstrate that its PROCTOR Mark is famous, and therefore, is not entitled to dilution protection.

4. Opposer's claims are barred because Opposer's Mark PROCTOR is generic for the providing administration and delivery of testing and training and for providing tests centers where the computer based testing and training sessions occur.

5. Opposer's claims are barred because Opposer's Mark PROCTOR is descriptive for the providing administration and delivery of testing and training and for providing tests centers where the computer based testing and training sessions occur.

6. WHEREFORE, Applicant prays that this Opposition proceeding be dismissed in its entirety, and that its Notice of Allowance issue forthwith.

CANCELLATION COUNTERCLAIM

ProctorU believes that it is damaged by FINRA's continued registration of the mark PROCTOR in Registration Nos. 1,768,263, 1,766,565, 1,920,891, and 1,797,000, and hereby requests cancellation of the same.

The grounds for this counterclaim are as follows:

1. FINRA asserts that it is involved in the registration of securities markets, brokerage firms, and individual brokers. FINRA asserts that it develops rules and regulations, and designs and operates marketplace services and facilities for use by investment brokerage firms and their employees. As such, the scope of its services covered by their marks should be limited to the below services in connection with registration of securities markets, brokerage firms, and individual brokers .

2. FINRA asserts that it is the owner of U.S. Trademark Registration No. 1,768,263 which covers training, educational testing certification of professional employment skills and abilities in class 042. If FINRA was ever entitled to such a broad registration, they have long since abandoned their use of the mark for any market beyond brokerage firms and individual brokers. Extension of the services beyond FINRA's admittedly limited scope of

services for securities markets, brokerage firms and individual brokers is overly broad and should be cancelled for services other than training, educational testing and certification of financial professionals and employment skills and abilities for brokerage firms and individual brokers.

3. FINRA asserts that it is the owner of U.S. Trademark Registration No. 1,766,565 for computer programs for training, testing, and certification of professional and employment skills and abilities in Class 009. If FINRA was ever entitled to such a broad registration, they have long since abandoned their use of the mark for any market beyond brokerage firms and individual brokers. Extension of the services beyond FINRA's admittedly limited scope of services for securities markets, brokerage firms and individual brokers is overly broad and should be cancelled for services other than training, educational testing and certification of financial professionals and employment skills and abilities for brokerage firms and individual brokers.

4. FINRA asserts that it is owner of Federal Registration No. 1,920,891 for the mark PROCTOR covering booklets, pamphlets and brochures for training, testing, and certification of professional and employment skills and abilities in Class 016. If FINRA was ever entitled to such a broad registration, they have long since abandoned their use of the mark for any market beyond brokerage firms and individual brokers. Extension of the services beyond FINRA's admittedly limited scope of services for securities markets, brokerage firms and individual brokers is overly broad and should be cancelled for services other than training, educational testing and certification of financial professionals and employment skills and abilities for brokerage firms and individual brokers.

5. FINRA asserts that it is the owner of Federal Trademark Registration No. 1,797,000 for the mark PROCTOR covering computer facilities manuals for training, testing, and certification of professionals and employment skills and abilities in Class 016. If FINRA was ever entitled to such a broad registration, they have long since abandoned their use of the mark for any market beyond brokerage firms and individual brokers. Extension of the services beyond FINRA's admittedly limited scope of services for securities markets, brokerage firms and individual brokers is overly broad and should be cancelled for services other than training, educational testing and certification of financial professionals and employment skills and abilities for brokerage firms and individual brokers.

6. In view of the above allegations, FINRA is not entitled to continued registration of its mark because FINRA has abandoned the marks in connection with any goods and services outside of the goods and services provided to brokers and brokerage houses.

WHEREFORE, PROCTORU believes that it will be damaged by continued registration of FINRA's PROCTOR marks, and prays that this Cancellation Counterclaim be sustained and that registration numbers 1,768,263; 1,766,565; 1,920,891; and 1,797,000 be cancelled.

Please charge the fee for filing the Cancellation Counterclaim to Deposit Account No. 04-1105.

Respectfully submitted,

ProctorU, Inc.

By Its Attorney's

By: 

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CERTIFICATE OF SERVICE

I hereby certify that on August 3, 2012, a true and correct copy of the foregoing **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION** has been served by mailing said copy, via first-class mail, addressed to attorney of record for Financial Industry Regulatory Authority, Inc...:

Morgan Lewis & Bockius
Carla B. Oakley
One Market Street, Spear Tower
San Francisco, California 941005-1126

Date:

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CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION** is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this third of August 2012.

Howard M. Gitten

Howard M. Gitten